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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,727	08/25/2003	Mark E. Pecen	CS23174RA	2148
20280 7590 06/06/2007 MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			EXAMINER CHURNET, DARGAYE H	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 06/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/647,727		PECEN ET AL.	
	Examiner		Art Unit	
	Dargaye H. Churnet		2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 and 26-35 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,15,17-19,21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 2,7,16,18,20 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/16/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Objections – Abstract

1. The abstract is objected to because it should only be one paragraph.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23, line 1, the term "said true/false indicators" has no antecedent basis. There are no true/false indicators mentioned in claim 19.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 5, 6, 15, 19, 21, 24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalsgaard et al. (cited 6,546,251 B1).

For claim 1, Dalsgaard et al. disclose a method of cell reselection by a mobile station communicating with a serving cell comprising: receiving from the serving cell an information element having an indicator corresponding to the routing area of each of a set of neighbor cells (see col. 6, lines 47-52, wherein the mobile station receives information about the location area or neighboring cells); comparing a neighbor cell routing area to the serving cell routing area (see col. 6, lines 47-52, wherein the neighbor cells location area is compared with the current location area); and executing a reselection decision in response to comparing the neighbor cell routing area to the serving cell routing area (see col. 6, lines 59-65, wherein the mobile stations reselects a neighboring cell as the serving cell).

For claim 5, Dalsgaard et al. disclose determining whether a radio link budget criteria is acceptable for said serving cell (see col. 6, lines 59-65, wherein radio link budget criteria analyzed include power level of received signals and error rate of decoded signals).

For claim 6, Dalsgaard et al. disclose the information element is transmitted to the mobile station from said serving cell as one of an SI2, SI2bis, SI5, and SI5bis message (see col. 6, lines 42-45, wherein information transmitted to the mobile station is in the form of an SI message). Claim 21 is rejected for similar reasons.

For claim 15, Dalsgaard et al. disclose a method of cell reselection by a mobile station communicating with a serving cell comprising: receiving from the serving cell, a radio link budget criteria for packet transfer mode operation (see col. 6, lines 28-32, wherein the mobile station receives messages from packet broadcast control channels); determining whether the radio link budget criteria is acceptable for the serving cell (see col. 6, lines 63-65, wherein radio link budget criteria such as power level of signals and error rates of decoded signals are measured); and executing a reselection decision in response to determining whether said radio link budget criteria is acceptable for the serving cell (see col. 6, lines 59-65, wherein a mobile station selects the neighboring as the serving cell on the basis of the channel measurements).

For claim 19, Dalsgaard et al. disclose a communications system comprising: at least one base transceiver station configurable to transmit an information element for indication of whether neighbor list base transceiver stations are associated with a routing area (see col. 6, lines 47-52, wherein a base station transmits information to find other base stations within neighboring cells in the same location area); and at least one mobile station configurable to receive the information element and to avoid cell reselection based upon the information element (see col. 6 line 66 – col. 7 line 5, wherein the mobile station changes cells only when the new cell has met the suitable criteria, or else the cell will be avoided).

For claim 24, Dalsgaard et al. disclose a communication system comprising: at least one base transceiver station configurable to transmit a mode specific radio link budget parameter (see col. 6, lines 35-39, wherein the current base station transmits information describing if neighboring base stations can support current radio link parameters); and at least one mobile station configurable to receive the mode specific radio link budget parameter and to determine whether to perform cell reselection based upon the mode specific radio link budget parameter (see col. 6, lines 28-32, wherein a mobile station determines if it will change cells based on the information from the base station).

For claim 25, Dalsgaard et al. disclose the mode specific radio link budget parameter is a packet data transfer mode radio link budget parameter (see col. 6, lines 28-32, wherein the PSI3 messages are transmitted as packets).

Claim Rejections - 35 USC § 103

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalsgaard et al. in view of Bontempi et al. (cited 7,058,042 B2).

For claim 3, Dalsgaard et al. fail to disclose determining that the mobile station is operating in a packet data transfer mode. Bontempi et al. from the same or similar fields of endeavor teaches determining that the mobile station is operating in a packet data transfer mode (see col. 7, lines 37-40, wherein a mobile station can operate in a packet mode). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Bontempi et al.

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in the network of Dalsgaard et al. The method taught by Bontempi et al. is modified/implemented into the network of Dalsgaard et al. by providing a packet data transfer mode. The motivation for determining that the mobile station is operating in a packet data transfer mode is to perform the appropriate cell reselection process. Claim 17 is rejected for similar reasons.

For claim 4, Dalsgaard et al. fail to disclose determining that the mobile station is operating in a push-to-talk mode. Bontempi et al. from the same or similar fields of endeavor teaches determining that the mobile station is operating in a push-to-talk mode (see col. 8, lines 38-40, wherein a mobile station can operate in a push-to-talk mode). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Bontempi et al. in the network of Dalsgaard et al. The method taught by Bontempi et al. is modified/implemented into the network of Dalsgaard et al. by providing a push-to-talk mode. The motivation for determining that the mobile station is operating in a packet data transfer mode is to perform the appropriate cell reselection process. Claim 18 is rejected for similar reasons.

Allowable Subject Matter

7. Claims 2, 7, 16, 20, and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 8-14 and 26-35 are allowable.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references include Alto (cited 5,862,489) and Dahlin (cited 5,140,627).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dargaye H. Churnet whose telephone number is 571-270-1417. The examiner can normally be reached on Monday-Friday from 7:30-5:00.

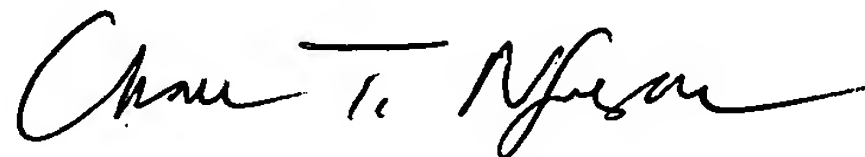
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dargaye Churnet
Patent Examiner
Art Unit 2616



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600